

REMARKS

Claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50 are pending and are rejected. In this response, claims 1, 15, 33, and 47 have been amended. New claims 55-57 have been added. In view of the following remarks, reconsideration and allowance of the present application, as amended, is respectfully requested.

Claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48, and 50 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Conklin (Jeff Conklin et al., "gIBIS: A Hypertext Tool for Exploratory Policy Discussion, ACM Transactions on Office Information Systems, Vol. 6, No.4, October 1988, Pages 303-331) in view of Hirose (U.S. Patent No. 5,784,286) and Regli (W.C. Regli et al., "A Survey of Design Rationale Systems: Approaches, Representation, Capture and Retrieval," 2000, Engineering with Computers, Vol. 16, Pages 209-235). This ground of rejection is respectfully traversed.

"In rejecting a claim under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). This burden includes establishing that the combination of prior art references teach or suggest all the claim limitations. A seminal case directed to application of 35 U.S.C. § 103 is *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). From this case, four familiar factual inquiries have resulted. The first three are directed to the evaluation of prior art relative to the claims at issue, including whether the rejection properly considers the differences between the prior art and the subject claim. The last is directed to evaluating evidence of secondary considerations. See also *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 (2007) ("While the sequence of these questions might be reordered in any particular case, the [Graham] factors

continue to define the inquiry that controls.”). Additionally, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) cited with approval in *KSR*.

The cited references fail to disclose, teach, or suggest that “each node appears only once in each of said plurality of files” as recited in claims 1 and 33. In previously rejecting claim 15, the Examiner cited to Figure 2 in Conklin on page 306 as showing “each node appears once only.” The Examiner acknowledged that Conklin failed to disclose “a plurality of files.” The Examiner cited Figure 2 in Regli on page 213 as an attempt to remedy Conklin’s shortcoming. As explained below, both references, alone or in combination, fail to disclose that “each node appears only once in each of said plurality of files” as recited in claims 1 and 33.

The Conklin reference discloses an “experimental version” of the gIBIS system. Conklin at p. 303. Figure 2 shows an example of a gIBIS interface. Conklin at p. 306. Nothing in Figure 2 or the description in Conklin discloses, teaches, or suggests that a node only appears once in a file. Notably, Conklin discloses the *opposite*. In describing the gIBIS tool, Conklin states, “The method makes it harder for discussants to make unconstructive rhetorical moves, such as ‘argument by repetition’. . . .” Conklin at p. 305. Rather than precluding repetition of a node, such as an argument, the Conklin reference allows the same argument to be repeated. In addition, the Examiner has admitted that Conklin only discloses the use of one record or file. Therefore, Conklin

teaches the opposite of the present claim limitation by permitting a node to appear more than once in a given file.

Conklin's gIBIS system is consistent with other prior art systems that permit a node to appear more than once in a file. Indeed, the present application noted that failure in the prior art when describing this claim limitation: "This feature provides a clearly defined context, not present in state of the art knowledge capture tools where there is potential for the node to appear on multiple views." U.S. Patent App. No. 10/507,002, p. 10, ll. 9-12. Prior art systems, like Conklin, allowed the same node to appear more than once in a file, thereby allowing the node to appear in multiple views. In contrast to these prior art systems, claims 1 and 33 recite that "each node appears only once in each of the plurality of files."

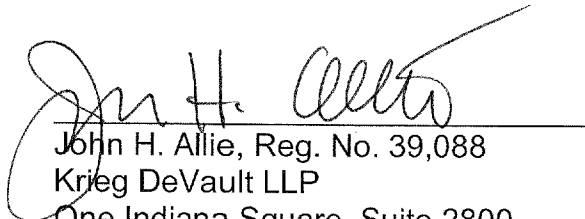
Regli fails to remedy the shortcomings of Conklin. The Regli reference is merely "a survey on recent research in the area of design rationale." Regli, p. 209. Furthermore, Figure 2 in Regli, cited by the Examiner, is not representative of any actual system, but is instead a hypothetical system: "Figure 2 shows the architecture of a general design rationale system, generated from our survey by synthesising [sic] the functions of different systems. The design rationale systems or prototypes that we reviewed generally did not include all of the features indicated in the diagram." Regli, p. 212. Neither Figure 2 nor the description in Regli disclose that "each node appears only once in each of said plurality of files" as recited in claims 1 and 33.

Accordingly, independent claims 1 and 33 are patentable over Conklin, Hirose, and Regli and withdrawal of this rejection is respectfully requested. Claims 2, 4-6, 8, 10, 15, 17-19, and 22 depend from base claim 1 and are patentable for at least the

reasons supporting patentability of base claim 1. Claims 41, 47, 48, and 50 include the limitations of claim 33 and are patentable for at least the reasons supporting patentability of claim 33. In addition, new claims 55-57 are patentable for at least the reasons supporting patentability of claims 1 and 33.

For the foregoing reasons, Applicant submits that the cited references do not disclose, teach, or suggest the subject matter of the pending claims. The pending claims are therefore in condition for allowance, and Applicant respectfully requests withdrawal of the rejection and allowance of the claims. The Examiner is cordially invited to contact the undersigned by telephone to discuss any unresolved matters.

Respectfully submitted,



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